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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/813,908	03/26/2004	Joachim Frey	4616-68296-01/RJP	5049
24197	7590	04/22/2005	EXAMINER	
KLARQUIST SPARKMAN, LLP 121 SW SALMON STREET SUITE 1600 PORTLAND, OR 97204			SWARTZ, RODNEY P	
			ART UNIT	PAPER NUMBER
			1645	

DATE MAILED: 04/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/813,908

**Applicant(s)**

FREY ET AL.

**Examiner**

Rodney P. Swartz, Ph.D.

**Art Unit**

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on Preliminary Amendment.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 23-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 23-36 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicants' Preliminary Amendment, received 18 October 2004, is acknowledged. Claims 1-22 have been cancelled. New claims 23-36 have been added.
2. Claims 23-36 are pending.

### Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 24, 25, 27, and 28, drawn to DNA, classified in class 536, subclass 23.7.
  - II. Claims 33 and 34, drawn to method of immunization of fish using DNA, classified in class 424, subclass 9.2.
  - III. Claims 23 and 26, drawn to polypeptide, classified in class 424, subclass 234.1.
  - IV. Claims 29-32, drawn to method of immunization of fish using polypeptide, classified in class 424, subclass 9.1.
  - V. Claims 35 and 36, drawn to method of passive immunization using antibody, classified in class 424, subclass 139.1.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the DNA of Invention I can be utilized *in vitro* for protein synthesis.

Inventions I and III are drawn to structurally and functionally distinct molecules.

Invention I is drawn to nucleic acids while Invention III is drawn to amino acids.

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Inventions I and IV are drawn to structurally and functionally distinct molecules.

Invention I is drawn to nucleic acids while Invention IV is drawn to amino acids utilized in immunization.

Inventions I and V are drawn to structurally and functionally distinct molecules.

Invention I is drawn to nucleic acids while Invention V is drawn to antibodies utilized in passive immunization.

Inventions II and III are drawn to structurally and functionally distinct molecules.

Invention II is drawn to nucleic acids while Invention III is drawn to amino acids.

Inventions II and IV are drawn to structurally and functionally distinct molecules.

Invention II is drawn a method utilizing nucleic acids while Invention IV is drawn to a method utilizing amino acids.

Inventions II and V are drawn to structurally and functionally distinct molecules.

Invention II is drawn to nucleic acids while Invention Invention V is drawn to antibodies utilized in passive immunization.

Inventions III and IV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the polypeptide of Invention III can be utilized *in vitro* for immunoassays to detect infection.

Inventions III and V are drawn to structurally and functionally distinct molecules.

Invention III is drawn to amino acids while Invention Invention V is drawn to antibodies utilized in passive immunization.

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Inventions IV and V are drawn to structurally and functionally distinct molecules.

Invention IV is drawn to a method utilizing bacterial amino acids while Invention Invention V is drawn to antibodies utilized in passive immunization.

Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, and because while the searches may overlap, the searches are not coextensive, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rodney P. Swartz, Ph.D., Art Unit 1645, whose telephone number is (571) 272-0865. The examiner can normally be reached on Monday through Thursday from 5:30 AM to 4:00 PM EST.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Lynette F. Smith, can be reached on (571)272-0864.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



RODNEY P SWARTZ, PH.D  
PRIMARY EXAMINER  
Art Unit 1645

April 19, 2005